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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 09/698,362  | 10/27/2000  | Phillip S. Pound     | NORT-0082<br>(13421RRUS01U) | 5842             |
| 21906   | 7590        | 04/21/2004           | EXAMINER                    |                  |
| TROP PRUNER & HU, PC<br>8554 KATY FREEWAY<br>SUITE 100<br>HOUSTON, TX 77024 |             |                      | ENG, GEORGE                 |                  |
|   |             |                      | ART UNIT                    | PAPER NUMBER     |
|   |             |                      | 2643                        | 12               |

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/698,362             | POUND, PHILLIP S.   |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | George Eng             | 2643                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 February 2004.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18,20-22,24,30-33,35,42-44,46,47 and 49-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18,20-22,24,30-33,35,42-44,46,47,49,50 and 54 is/are rejected.
- 7) Claim(s) 51-53 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed 2/5/2004 (paper no. 11).

### ***Claim Objections***

2. Claims 2-3 are objected to because of the following informalities: claims 2-3, line 3, "the party" should be --the remote party-- in order to unify the claimed limitation as amended in claim 1. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-18, 20, 22, 24, 30-33, 35, 42-44, 46-47, 49-50 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al. (US PAT. 6,584,490 hereinafter Schuster) in view of Tabata et al. (US PAT. 6,313,864 hereinafter Tabata).

Regarding claim 1; Schuster discloses a method for providing call-handling services on a data network telephone system comprising the steps of establishing a packet-based call session of a data network telephone with a remote data network telephone, i.e., a remote party, over an

Internet Protocol network (col. 6 lines 29-41), and receiving information associated with at least one physical attribute of the remote party during the packet-based call session (col. 7 lines 5-30 and col. 12 line 9 through col. 13 line 9). In addition, Schuster teaches the data network telephone is not limited to telephones or video telephone (col. 16 lines 54-67) so that one skill in the art would recognize the data network telephone capable of displaying image received from the remote data network telephone during the packet-based call session. Schuster differs from the claimed invention in not specifically teaching to animate at least a portion of the image associated with the remote party information based on the received information, the received information representing movement of the at least one physical attribute, and the received information being different from video data of the at least one physical attribute and to display the animated image. However, Tabata discloses an efficiency transferring method for communicating image and voice comprising the steps of receiving calling party information (i.e., a fundamental character data of the calling party) associated with the incoming call, receiving information associated with at least one physical attribute of the party, animating at least a portion of an image associated with the party information based on the received information, and display the animate image (col. 10 line 1 through col. 12 line 20 and col. 22 line 36 through col. 25 line 44), wherein the received information represents movement of the at least one physical attribute, which is in form of countenance code (col. 10 lines 33-61) that is different from character data, i.e., image data, of the at least one physical attribute. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Schuster in animating at least a portion of the image associated with the party information based on the received information, the received information representing movement of the at least one

physical attribute, and the received information being different from video data of the at least one physical attribute and to display the animated image, as per teaching of Tabata, because it provides an efficiency transferring method for communicating image and voice without significant burdens to the users in terms of preparation time and effort.

Regarding claims 2-3, Tabata discloses receiving information associated with at least one physical attribute of the party comprising receiving information associated with facial expressions of the party, i.e., command signal codes in accordance with the eye and lip movement data (col. 10 lines 41-53).

Regarding claim 4, Tabata discloses to alter the mouth (i.e., lips) of the image (col. 12 lines 9-13).

Regarding claim 6, Tabata teaches to receive information associated with at least one physical attribute comprising data, i.e., a numeric value, associated with one of a plurality of facial expression (col. 15 lines 8-18 and col. 17 liens 44-53).

Regarding claim 7, Tabata teaches to receiving voice signal as receiving the incoming call (col. 12 lines 5-8).

Regarding claim 8, Tabata teaches to display an image of moving lips of the party that are substantially synchronized with the voice signals (col. 7 line 63 through col. 8 line 15).

Regarding claim 9, Schuster teaches to establish the packet-based call session over an Internet Protocol network comprising to establish the packet-based call session over a wireless link (col. 6 line 57 through col. 7 line 46).

Regarding claim 10, Schuster discloses an apparatus (408) as shown in 3 comprising an interface (608) adapted to receiving voice information and image information in a call session

with a party, at least one storage device (606) to store user information, and a controller (604) adapted to communicate over a packet-based network, i.e., internet, to establish the call session, wherein the controller is adapted to communicate Session Initiation Protocol (SIP) messaging to establish the call session (col. 6 lines 29-41 and col. 7 lines 5-30 and col. 12 line 9 through col. 13 line 9). In addition, Schuster teaches the data network telephone is not limited to telephones or video telephone (col. 16 lines 54-67) so that one skill in the art would recognize the interface adapted to receive image information representing of a facial expression of the remote party. Schuster differs from the claimed invention in not specifically teaching to store an electronic representation of an image of the remote party and to animate at least a portion of the electronic representation of the image based on the animation information and display the animated image, wherein the animation information is different from video data of the facial expression. However, Tabata discloses a device having character data memory means to store an electronic representation of an image of a party (col. 6 lines 34-36) and a controlling unit to animate at least a portion of the electronic representation of the image based on the animation information and display the animated image (col. 14 line 15 through col. 17 line 65), wherein the received information represents movement of the at least one physical attribute, which is in form of countenance code (col. 10 lines 33-61) that is different from character data, i.e., image data, of the at least one physical attribute. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Schuster in animating at least a portion of the image associated with the party information based on the animation information and displaying the animation image, wherein the animation information is different from video data of the facial expression, as per teaching of Tabata, because it makes capable of

communicating image and voice without significant burdens to the users in terms of preparation time and effort.

Regarding claims 11-12, Schuster teaches to receive session initiation protocol call set up messaging over a packet based network from a device associated with the party and to transmit session initiation protocol messaging over the packet-based network in response to the call set up messaging (col. 12 line 44 through col. 13 line 9), and Tabata discloses to receive calling party information associated with the call to access image based on the calling party information (col. 22 lines 51-66). Thus, the combination of Schuster and Tabata teaches the claimed limitations.

Regarding claim 13, the limitation of the claim are rejected as the same reasons set forth in claim 8.

Regarding claim 14, the limitation of the claim are rejected as the same reasons set forth in claim 6.

Regarding claims 15-16, Tabata discloses the controller capable of tracking physical attributes of a user of the apparatus, mapping the physical attributes of the user to a selected value, and to transmit the selected value to a remote telecommunication device (col. 6 line 56 through col. 7 line 6 and col. 11 lines 38-60).

Regarding claim 17, the limitations of the claim are rejected as the same reasons set forth in claim 9

Regarding claim 18, Schuster discloses an article comprising at least one machine-readable storage medium containing instruction that when executed cause a processor to over a packet-based network, i.e., internet, to establish the call session so that it recognizes the controller is adapted to communicate Session Initiation Protocol (SIP) messaging to establish the

call session, wherein the processor is capable of receiving a voice signal from a participant in the call session (col. 6 lines 29-41 and col. 7 lines 5-30 and col. 12 line 9 through col. 13 line 9). In addition, Schuster teaches the data network telephone is not limited to telephones or video telephone (col. 16 lines 54-67) so that it recognizes the data network telephone capable of receiving information representing at least a portion of a face of the participant. Schuster differs from the claimed invention in not specifically teaching to animate an image based on the received information so that movement of the face is substantially synchronized with the voice signal, wherein the received information represents movement of the at least one physical attribute, which is different from video data of the at least one physical attribute and to display the animated image. However, Tabata discloses to receive an image comprising at least a portion of a face of the participant and modify a portion of the image so that the movement of the face is substantially synchronized with the voice signal (col. 7 lines 18-37, col. 10 line 1 through col. 12 line 20 and col. 22 line 36 through col. 25 line 44), wherein the received information represents movement of the at least one physical attribute, which is in form of countenance code (col. 10 lines 33-61) that is different from character data, i.e., image data, of the at least one physical attribute. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Schuster in animating the image associated based on the received information, as per teaching of Tabata, because it makes capable of communicating image and voice without significant burdens to the users in terms of preparation time and effort.

Regarding claim 20, Tabata teaches to receive the image from a storage device over the call session (col. 10 lines 12-26).

Regarding claim 22 and 24, Tabata teaches to map information over the call session, to modify the portion of the image based on the information and to display the portion of the image, wherein animating the image is based on the mapping information (col. 22 line 36 through col. 25 line 44).

Regarding claim 30, the limitations of the claim are rejected as the same reasons set forth in claim 10.

Regarding claim 31, the limitation of the claim are rejected as the same reasons set forth in claims 2-3.

Regarding claim 32, the limitation of the claim are rejected as the same reasons set forth in claim 7.

Regarding claim 33, the limitation of the claim are rejected as the same reasons set forth in claim 8.

Regarding claim 35, the limitations of the claim are rejected as the same reasons set forth in claim 1.

Regarding claims 42-46, Tabata teaches the animation information consuming less bandwidth than video image data representing user (col. 1 line 17 through col. 2 line 59).

Regarding claim 47, Schuster discloses to establish the packet-based call session comprising communicating Session Initiation Protocol messaging to establish the packet-base call session (col. 9 line 39 through col. 10 line 32 and col. 18 liens 2-38).

Regarding claim 49, the limitations of the claim are rejected as the same reasons set forth in claim 47.

Regarding claim 50, the limitations of the claim are rejected as the same reasons set forth in claim 48.

Regarding claim 54, the limitations of the claim are rejected as the same reasons set forth in claim 9

5. Claims 5 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al. (US PAT. 6,584,490 hereinafter Schuster) in view of Tabata et al. (US PAT. 6,313,864 hereinafter Tabata) as applied in claims above, and further in view of Hsu (US PAT. 5,907,604).

Regarding claim 5, Tabata discloses to receive calling party information comprising an image of a speaker on a sending side (col. 10 lines 12-17 and col. 22 lines 51-64). The combination of Schuster and Tabata differs from the claimed invention in not specifically teaching to receive calling party information comprising at least one of a phone number and name associated with the incoming call. However, it is old and notoriously well known in the art of receiving calling party information comprising at least one of a phone number and name associated with the incoming call, i.e., caller ID, in order to use the calling party information to determine whether to allow the call to go through, to block the call, or to display the information on a display, for example see Hsu (col. 1 line 66 through col. 2 line 42 and col. 3 line 66 through col. 4 line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the combination of Schuster and Tabata in receiving calling party information comprising at least one of a phone number and name associated with the incoming call, as per teaching of Hsu, in order to use the calling party information to

determine whether to allow the call to go through, to block the call, or to display the information on a display.

Regarding claim 21, the limitations of the claim are rejected as the same reasons set forth in claim 5.

#### *Allowable Subject Matter*

6. Claims 51-53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Response to Arguments*

7. Applicant's arguments filed 2/5/2004 (paper no. 11) have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments that the combination of Schuster and Tabata fails to disclose the steps of receiving information associated with at least one physical attributes of a remote party during a packet based call session, where the receive information is different from the video data of the at least one physical attribute, Schuster clearly teaches to receive information of a remote party during a packet based call session (col. 7 lines 5-30 and col. 12

line 9 through col. 13 line 9), and Tabata clearly teaches to receive information associated with at least one physical attribute of a party, displaying an associated image, where the received information represents movement of the at least one physical attribute and the received information is different from video data of the at least one physical attribute, i.e., countenance code (col. 10 lines 33-61). Thus, the combination of Schuster and Tabata is enough to reject the claimed limitations.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Schuster and Tabata are combinable because they are in the same field of endeavor, i.e., providing call-handling service in a communication system. The motivation of combining Schuster with Tabata is to provide an efficiency communication method for transferring image and countenance changes in a real time using simple and low cost devices without significant burdens to the users in term of preparation time and effort (col. 28 lines 15-20).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any response to this final action should be mailed to:

BOX AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, V.A., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Eng whose telephone number is 703-308-9555. The examiner can normally be reached on Tuesday to Friday from 7:30 AM to 6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis A. Kuntz, can be reached on (703) 305-4870. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



George Eng  
Primary Examiner  
Art Unit 2643